

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Robert M. Levin
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ATTENTION: Board of Patent Appeals and Interferences

APPELLANT'S BRIEF (37 C.F.R. 41.37)

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The final page of this brief bears the practitioner's signature.

I REAL PARTY IN INTEREST (37 C.F.R. 41.37(c)(1)(i))

The real party in interest in this appeal is Robert M. Levin, the applicant in the above-referenced application.

II RELATED APPEALS AND INTERFERENCES (37 C.F.R. 41.37(c)(1)(ii))

There are no other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal.

III STATUS OF CLAIMS (37 C.F.R. 41.37(c)(1)(iii))

The status of the claims in this application are:

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

One.

B. STATUS OF THE CLAIMS

Claim 1 is rejected.

C. CLAIMS ON APPEAL

Claim 1 is on appeal.

IV STATUS OF AMENDMENTS (37 C.F.R. 41.37(c)(1)(iv))

No amendment was filed subsequent to the final rejection.

V SUMMARY OF THE CLAIMED SUBJECT MATTER (37 C.F.R. 41.37(c)(1)(v))

Applicant's claim 1 is directed to:

An educational method for increasing a students' vocabulary comprising the steps of:

identifying a first expression consisting of a commonly known person, place, thing, event, title, phrase or quote consisting of one or more words in tangible form;

obscuring said words by substituting one or more of said words with lesser known words to form a second expression;

presenting the second expression to a student in tangible form to decipher using his vocabulary knowledge of said lesser known words;

Specification p. 2, line 22: "The present invention is a vocabulary building method..."

Specification p. 3, lines 3-5: "...a common title, name, thing or phrase such as "All Dogs Go To Heaven"... is identified by the person constructing the puzzle. The words are fixed in a tangible form. Specification p. 1, lines 26-27: "...adapted to a variety of media including but not limited to print media forms such as in a newspaper or puzzle book, as a board game, as an Internet game, or as a computer game."

Specification p. 3, lines 4-5: The first expression is translated by the person constructing the puzzle "using words that may not be common to the student (e.g., Curs are supernally fated in every case)." Specification p. 4, lines 2-3: The ... "sesquipedalian (word or string of not commonly known complex words)" forms the second expression.

Specification p. 3, lines 4-5: "The student(s) are presented with a common title, name, thing, or phrase such as "All Dogs Go To Heaven" using words that may not be common to the student (e.g., Curs are supernally fated in every case."

See also specification p. 3, lines 4-5: The student uses his vocabulary to decipher the common phrase, name, thing or title (e.g., Curs are supernally fated in very case." Also see Fig. 1, refs. 5, 9 and 13 for examples of other second expressions to decipher:

Undaunted pneuma (5); Cephalic dyad (9)
and During the caloric effect of the vesper (13).

providing said student with one or more definitions in tangible form of the lesser known words which definitions serve as clues for deciphering the second expression back into the first expression; and,

Specification p. 3, lines 6-8: "...the student is presented with a number of clues, each of which provides the definition of one or more of the unknown words." Also see Specification p. 4 lines 9-10: "With each vocabulary building exercise is a series of clues 7, 11, & 15 which can be used to assist the student in deciphering the sesquipedalian." For example, the clues to decipher "Undaunted pneuma" are ref. 7 Clue #1 undaunted means courageous and resolute; brave. If the movie title BRAVE HEART does not come to mind. Clue # 2 pneuma means the soul; spirit

scoring the student based on the number of the definitions in tangible form used to decipher the second expression back into the first expression

Specification p. 4, lines 13-25 describes the step of scoring the student depending on the number of clues used by the student. Also see Fig. 1: If no clues are needed, the student scores 16, 3 bonus points for each clue not used. If the student needs only one clue, he scores 13. If he needs both clues but deciphers the puzzle back into the first expression, he scores 10. If he cannot solve the puzzle, he scores 0.

whereby said student learns the lesser known words and adds them to his vocabulary by actively using said definitions of the lesser known words in deciphering the second expression back into the first expression.

Specification p. 4, lines 19-21: "After studying the clue, the student again attempts to decipher the sesquipedalian. If he or she is successful, the student has increased his or her vocabulary..."

VI GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL (37 C.F.R.
41.37(c)(1)(vi))

Whether claim 1 is unpatentable under 35 U.S.C. 101 as being drawn to an abstract idea.

VII ARGUMENTS (37 C.F.R. 41.37(c)(1)(vii))

This is the second appeal to the Board on this application: See Appeal 2009-011966 wherein the Examiner's decision to reject claims 1 and 3 under 35 U.S.C. 103 was reversed. After the Board's decision, the Examiner reopened prosecution and rejected the claims under Section 101. In response, applicant amended claim 1 into the form presented on this appeal and canceled claim 3.

Claim 1 in this case recites steps for teaching vocabulary when played in a tangible form. A common word or phrase is "identified...in a tangible form" by the puzzle maker, the word or phrase translated into more challenging vocabulary by the puzzle maker and is "presented... in a tangible form" to the player and clues are "provided...in a tangible form" to the player. The player is scored depending on how many clues he or she takes to back translate the challenging vocabulary into the common word or phrase. Claim 1 does not read on the game if it is practiced orally and does not give applicant a monopoly on the concept.

Previously it was the practice of the PTO to reject patent claims which did not involve a machine or transformation as nonstatutory. The Supreme Court in In re Bilski rejected the machine-or-transformation test as the only test and pointed out that there are only three categories of subject matter outside the eligibility constraints of Section 101: laws of nature, physical phenomena; and abstract ideas.

Applicant's claim 1 does not satisfy the machine-or-transformation test but reads on a practical application of an abstract idea in a manner that does not preempt the abstract idea. More particularly, the claimed invention provides a method for introducing new vocabulary words building upon the existing vocabulary of the student. The method accomplishes a practical application, i.e., the method produces a "useful, concrete and tangible result" which can be tested: The student may be given an examination to determine whether the new words have in fact been learned.

Teaching is an abstract idea but applicant's method is patentable subject matter because the patent claim is to a practical application of the abstract idea. While no article or physical object is transformed into a different state, the claimed method produces a useful, concrete and tangible result.

The method is "useful" because the utility of the steps is (i) specific, (ii) substantial and (iii) credible. It is true that in some instances, a student may practice the method and learn nothing but learning usually results from the immediate and practical application of a new fact. This is why there are chemistry labs following a lecture which allow the student to apply newly acquired information to a practical purpose. In like manner, the present method allows the student to use his or her existing vocabulary to learn a new word and immediately use the new word to solve a puzzle.

Applicant's claimed method produces a "tangible" result. The real-world result is that the student learns a new word or words which result is testable.

Applicant's claimed method produces a "concrete" result. If the student is engaged he will predictably learn which result is testable.

Claim 1 does not cover every "substantial practical application" of the idea which underlies the teaching method. Protection is only sought for the teaching method in conjunction with all of the other steps in the claimed process, i.e., the words and clues are all presented in tangible form only. Applicant's claim does not preempt all practical use of the idea or preempt the teaching concept, just when it is practiced in a tangible copyrightable form such as in a newspaper, puzzle book, computer, Internet or other such media. Accordingly, withdrawal of the rejection under Section 101 is respectfully requested.

VIII CLAIMS APPENDIX (37 C.F.R. 41.37(c)(1)(viii))

The text of the claim involved in the appeal is:

Claim 1. An educational method for increasing a student's vocabulary comprising the steps of:

identifying a first expression consisting of a commonly known person, place, thing, event, title, phrase, or quote consisting of one or more words in tangible form;

obscuring said words by substituting one or more of said words with lesser known words to form a second expression;

presenting the second expression to a student in tangible form to decipher using his vocabulary knowledge of said lesser known words;

providing said student with one or more definitions in tangible form of the lesser known words which definitions serve as clues for deciphering the second expression back into the first expression; and,

scoring the student based on the number of the definitions in tangible form used to decipher the second expression back into the first expression

whereby said student learns the lesser known words and adds them to his vocabulary by actively using said definitions of the lesser known words in deciphering the second expression back into the first expression.

IX EVIDENCE APPENDIX

No evidence is presented.

X RELATED PROCEEDINGS APPENDIX

There are no related proceedings.

There are no further materials, that are necessary or desirable, required in consideration of this appeal.

Respectfully submitted,

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CERTIFICATE OF TRANSMISSION

I hereby certify that this Appellant's Brief is being electronically transmitted to the Patent and Trademark Office by EFS-Web on December 14, 2011.

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